



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,214	03/31/2000	Jay S. Walker	00-006	9740

22927 7590 07/07/2006

WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,214

Applicant(s)

WALKER ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-23,25-29,34-36,38,39,41,56,57,61,63,69-80,97 and 99-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-23,25-29,34-36,38,39,41,56,57,61,63,69-80,97 and 99-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, 97 and 99-118 have been examined.

Response to Amendment

2. The Amendment filed on 6/8/06 is insufficient to overcome the prior rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/8/06 has been entered.

Priority

4. Applicant's claim for domestic priority is acknowledged. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for the independent claims of this application. Applicant's request for priority to US Patent Application 08/889,503 (now US Patent 6,249,772) is not granted. US Patent 6,249,772 does not disclose numerous features of the Applicant's independent claims. Therefore, because features are not adequately supported in the disclosure of the cited parent application, this application (09/540,214) does not receive a priority date to the cited parent applications 6,249,772. Examiner notes that all features of the independent claims must be present in the disclosure of

Art Unit: 3622

the parent application in order to receive priority to that application. However, the Applicant has been found to have support for the claims as presently written in the 6,754,636 Patent. Hence, the Applicant's Priority Date for the 09/540,214 application is 6/22/1999 which is the priority date of the 6,754,636 Patent.

Also, if applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e) or 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the

Art Unit: 3622

required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Additionally, Patent Applications 09/190,744 and 08/707,660 are completely invalid for any priority claims in this Application 09/540,214. Patent Application 09/540,214 has a filing date of 3/31/00. Patent Application 09/190,744 has an abandonment date of 9/22/99 and patent application 08/707,660 has an issuance date of 8/11/98. Both of these dates are before the filing date for 09/540,214 which is 3/31/00. Hence, 09/190,744 and 08/707,660 are completely

Art Unit: 3622

invalid for any priority claims in this Patent Application 09/540,214. Also, note that Applicant made special comments concerning the significance of 09/190,744 on pages 23 and 24 of the Applicant's Remarks dated 6/8/2006. However, 09/190,744 is not valid for any priority claims in 09/540,214. Please see MPEP 35 USC 120 and MPEP § 201.11.

Hence, the Applicant's priority date is still 6/22/99.

Election/Restrictions

Newly submitted claim 116-118 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. Newly submitted claims are oriented towards a distinct invention such as the customer creating new, custom product category names and categories for product subsets.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 116-118 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

5. Claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, and 97, 99-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergh (6,112,186) in view of Von Kohorn (5,227,874) in view of Goddard (6,876,983) in view of Ojha (6,598,026).

Claims 1, 7, 10, 16-23, 25-29, 38, 39, 41, 56, 57, 61, 63, 69-80, and 97, 99-115: Bergh discloses a system and method for:

receiving from a customer an indication of a product category or a service category (col 3, lines 17-25; col 1, lines 24-32; col 11, lines 5-7; col 11, lines 49-53; col 27, lines 9-14).

Additionally, If a user can become more experienced in a particular domain, as Bergh discloses (col 11, lines 49-53), it is inherent that that user is selecting that domain more regularly. Bergh also discloses that the user can choose different product categories by selecting different websites (col 28, lines 5-11; col 28, lines 18-22). Bergh also discloses that user category and item selection in different categories can be interconnected (col 28, lines 10-15; col 28, lines 20-25; col 28, lines 49-53).

Bergh further discloses selecting for the customer one of the products in the product category or the services in the service category (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2; col 1, lines 50-54).

Bergh further discloses providing an indication of said selected one of said at least two products or said at least two services (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2).

Bergh further discloses a retailer category (col 1, lines 24-32; col 3, lines 17-25) where the retailer category is restaurants, clothing stores, World Wide Web pages, etc.

Bergh further discloses that the user makes a purchase (col 27, lines 65-col 28, lines 2).

Art Unit: 3622

Bergh does not explicitly disclose selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated the first product and the second product, and a willingness to purchase any one of the first product and the second product.

However, Von Kohorn discloses selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated the first product and the second product, and a willingness to purchase any one of the first product and the second product (col 99, line 37-col 100, line 5).

Von Kohorn further discloses indicating an area of interest (col 98, lines 33-36).

Von Kohorn further discloses targeting user with differing incentives (col 104, line 65-col 105, line 3; col 105, lines 17-24).

Von Kohorn further discloses targeting information to select groups of users (col 78, lines 40-52).

Von Kohorn further discloses utilizing competitive advertising to induce purchasing (col 105, lines 45-52) and that advertising can be in the form of incentives or coupons (col 8, lines 40-44; col 100, lines 60-68).

Von Kohorn further discloses that products from several sponsors can be provided as potential items of interest (col 83, lines 39-43).

Von Kohorn further discloses that the product can be a service or organization (col 100, lines 40-45) and that an organization can be a retailer (col 76, line 67-col 77, line 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn targeting user's based on items of interest for

Art Unit: 3622

purchasing to Bergh's targeting user's based on items of interest and user making purchases.

One would have been motivated to do this in order to allow flexible incentives for purchasing to be presented to users based on user interests.

Additionally, Von Kohorn discloses that the user selects item(s) that the user is interested in purchasing (col 99, lines 49-52). Note that the customer is presented a listing of many items that are available for purchase (col 99, lines 38-50) and that the user only selects the item(s) that the user is interested in purchasing (col 99, lines 49-52). Therefore, the user indicates a willingness to purchase at least one but not all of the plurality of products.

Von Kohorn also discloses selecting, for a customer, at least one of the products from a plurality of products (col 82, lines 20-55). Note that Von Kohorn's list includes all products for sale (col 82, lines 47-53) and that Von Kohorn selects for the customer product promotions for either or both of products the user selected and did not select as being interested in (col 82, lines 35-42).

Von Kohorn further discloses utilizing advertisements to entice a user to purchase a different or competing product from one the user would have normally selected (col 1, lines 45-55).

Von Kohorn further discloses the user selecting products, groups of products, competing products in different manners and forms (col 47, lines 5-15).

Additionally, Von Kohorn also discloses that the benefit is provided in exchange for the selecting (col 47, line 42-col 48, line 10; col 2, line 60-col 3, line 5; col 2, lines 49-53) and the benefit can be a prize, token, reward which can take many forms (col 11, lines 16-24; col 79, lines 19-25). Note that Von Kohorn discloses that a benefit can be awarded to the user for the

Art Unit: 3622

act of selecting a product. And, note that the benefit can take many forms including a cash payment.

Bergh does not explicitly disclose the user selecting a category of products and then selecting a product in that category for the user.

However, Goddard discloses the user selecting a category of products and then selecting a product in that category for the user:

“(106) A Tender for a One of a Group of Products or a Tender for a Product Defined by a Specification:

(107) The logic behind this process is that in many cases a shopper knows the specification of the product he/she wants to purchase, but he is willing to buy one of a group of products which fulfill this desired specification. For example if a shopper wishes to purchase a color television set with a 20" screen the system will form an open tender which will be submitted to manufacturers or suppliers of televisions complying with this specification. These manufacturers can either be specified, in which case the shopper knows a head of time that the television is to be purchased from a manufacturer included within a group of manufacturers specified by either the system or the shopper, or alternatively manufacturers are not specified. The system will evaluate the offers and decide on the best offer in accordance with the specification of the group, following which the deal is finalized” (col 13, lines 24-41).

Goddard further discloses the user indicating an amount the user is willing to pay (col 1, line 64-col 2, line 32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goddard user indicating a willingness to purchase one of a

Art Unit: 3622

plurality of products in a product category to Bergh's recommending one of a plurality of products in a product category and user making purchases. One would have been motivated to do this in order to better incite user purchasing.

Bergh does not explicitly disclose a penalty if the product is not purchased.

However, Ojha discloses a penalty if a user does not honor a commitment to make a purchase:

“(10) There are, however, some attendant disadvantages associated with allowing buyers to submit non-biding bids. For example, if there are no consequences to the buyer for submitting a bid, many bids may be submitted by a single buyer or a small group of buyers solely for the purpose of manipulating the market for a particular product. Moreover, resources may be wasted by a seller in pursuing a proliferation of non-serious bids. As discussed above, one solution is to require that a buyer submit a credit card number before he may submit a bid, and further to assess some financial penalty against the buyer's credit card if the buyer abandons the negotiation. Unfortunately, this may serve as a barrier to entry for many buyers in that they are much less likely to conduct simultaneous negotiations with a number of merchants under these conditions (col 2, lines 25-40);

(50) Additionally, the negotiations described above have been described largely as a non-biding process until after a mutually agreeable price has been found and the parties decide to consummate the deal. However, it will be understood that negotiations may be made partially or fully binding without departing from the scope of the invention. That is, a payment identifier such as, for example, a credit card or billing account may be requested before a

party is allowed to negotiate. If the party attempts to terminate negotiations prematurely, some sort of penalty may be assessed to the identified account” (col 21, lines 30-40).

Ojha further discloses flexibility in the different utilizations of Ojha’s disclosure:

“(51) Finally, many of the embodiments of the present invention have been described in a context in which a transaction site acts as an intermediary between buyers and sellers.

However, it will be understood that the scope of the present invention also encompasses negotiations, transactions, and other various features described herein when occurring directly between a buyer and a seller on, for example, the web site of the seller. These features include (but are not limited to) shopping lists, mutual exclusivity, request for quotes, buyer reputation, demand curve creation and use, block responses, bundle bid creation, cross-selling and all other aspects of the invention described above.

(52) Conceivably, any seller selling products at list prices on the Internet could get additional value by enabling negotiations and other related features as described herein. It is therefore important to note that the scope of this invention includes all of the features described herein, even where these features are enabled at the web sites of sellers who directly sell products to buyers. Therefore, the scope of the invention should be determined with reference to the appended claims” (col 21, lines 13-62).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha’s penalty for broken purchase commitments to Bergh’s recommendation and purchase method. One would have been motivated to do this in order to better assure buyer reliability and buyer capability of making purchases.

Bergh does not explicitly disclose providing a discount to the user.

Art Unit: 3622

Also, Ojha further discloses providing a benefit or discount to the user:

“(17) Each buyer's reputation is made available to sellers on the site for use as they see fit. For example, a seller could choose to respond only to bids from buyers who have a reputation which is of a certain level. Alternatively, a seller could choose to respond unfavorably to such buyers, thus giving the buyer immediate feedback and incentive to adjust her bid accordingly. In addition, a seller could give preferential treatment, e.g., discounts, to buyers with very good reputations. Thus, buyers would tend to conduct transactions in a responsible manner to protect their reputations from being damaged and to receive preferential treatment (col 3, lines 44-54);

(29) Similarly, in interface 1310, if the bid-list spread is between 10 and 50%, the actions taken are to reduce the ask price by 10% and present the text message "We have a great deal for you--we can offer you a 10% discount." Finally, as shown in interface 1312, if the bid is within 10% of the list price, an acceptance message is transmitted to the bidder” (col 16, lines 22-28).

Also, Von Kohorn discloses providing a benefit or discount to the user:

“Inducements can take the form of printouts, such as monetary coupons, dispensed in homes of broadcast audience members who have responded to a task” (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha or Von Kohorn's benefit or discount provided to the user to Bergh's user making purchases and providing services to the user. One would have been motivated to do this in order to better incite user purchasing.

Claims 6 and 34: Bergh and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of a product category including at least two products

Art Unit: 3622

or a service category including at least two services is completed by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 8 and 35: Bergh and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided to at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 9 and 36: Bergh and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 11: Bergh and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received from at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 12: Bergh and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 13-15: Bergh and Von Kohorn disclose a method as in claim 1.

Bergh further discloses receiving a customer identifier and determining a customer identifier (col 28, lines 47-56).

Art Unit: 3622

Bergh further discloses a purchase (col 27, line 65-col 28, line 2) and making a payment (col 19, lines 6-16).

Bergh does not explicitly disclose a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier.

However, Ojha discloses a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier (col 1, lines 25-35 and throughout the Ojha disclosure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Ojha's payment identifier to Bergh's purchase. One would have been motivated to do this because purchases can be efficiently tracked and completed utilizing payment identifiers.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 6-23, 25-29, 34-36, 38, 39, 41, 56, 57, 61, 63, 69-80, 97 and 99-118 have been considered but are not found persuasive.

On page 23 of the Applicant's Remarks dated 6/8/2006, Applicant states that Examiner has not considered the Applicants priority claims to 09/190,744, 08/889,319, or 08/707,660. However, the Examiner has not been able to locate where these priority claims were made. The Official PALM or PAIR Database lists the continuity chain as only including 09/337,906 06/22/1999 PAT 6,754,636 which is a CIP of 08/889,503 07/08/1997 PAT 6,249,772 which have already been addressed. Also, the BIB Data Sheet dated 3/31/2000, the Specification dated 3/31/2000, and the Specification Amendment dated 10/18/2000, all only state the 2 priority chain applications which have already been addressed. Hence, the Examiner has not been able to

Art Unit: 3622

locate any request to priority concerning the other three applications numbered: 09/190,744, 08/889,319, or 08/707,660.

Examiner notes that Applicant must list each and every application to which priority is to be sought in the Specification. Please see the expanded Priority section comments above. Also, please see 35 USC 120 which is repeated below:

“35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

Art Unit: 3622

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)”.

Additionally, Patent Applications 09/190,744 and 08/707,660 are completely invalid for any priority claims in this Application 09/540,214. Patent Application 09/540,214 has a filing date of 3/31/2000. Patent Application 09/190,744 has an abandonment date of 9/22/99 and patent application 08/707,660 has an issuance date of 8/11/98. Both of these dates are before the filing date for 09/540,214 which is 3/31/00. Hence, 09/190,744 and 08/707,660 are completely invalid for any priority claims in this Application 09/540,214. Also, note that Applicant made special comments concerning the significance of 09/190,744 on pages 23 and 24 of the Applicant's Remarks. However, 09/190,744 is not valid for any priority claims in 09/540,214. Please see MPEP 35 USC 120 and MPEP § 201.11.

Hence, the Applicant's priority date is still 6/22/99. And, both the Ojha and Goddard references predate the Applicant's priority date of 6/22/99 and are, therefore, still valid prior art.

Hence, the combination of the prior art still renders obvious the Applicant's stated claims.

Also, the following is in response to Applicant's arguments concerning motivations to combine the prior art.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what

Art Unit: 3622

the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, please see the motivations stated in the rejections above.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 3622

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Giovannoli (2006/0015413), Ross (6,993,572), Gerbaulet (5,544,040), and Van Horn (6,604,089) disclose indicating selecting a product from a product category that is available for purchase.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3622

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
6/22/2006